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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,269	07/03/2003	Scot Kevin Huber	022650-727	4089

7590 06/29/2004

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EXAMINER

SAEED, KAMAL A

ART UNIT PAPER NUMBER

1626

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/612,269	HUBER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kamal A Saeed	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 12-42 (all claims in part) and 43-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 12-42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/03/2003</u> | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

Claims 1-48 are pending in this application. Claims 1-11, 12-42 (all claims in part) and 43-48 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

***Information Disclosure Statement***

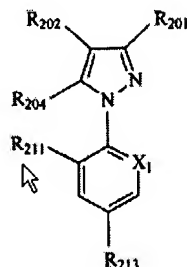
Applicant's Information Disclosure Statements, filed on July 03, 2003 have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

***Priority***

This Application is a DIV of US Application No. 10/342,203, filed January 15, 2003, now US Patent No. 6,630,499 B1, issued October 7, 2003, which is a DIV of US Application No. 09/590,069, now US Patent No. 6,531,501 B1, which is a CIP of US Application No. 09/457,869, filed December 10, 1999, now US Patent No. 6,160,002, issued December 12, 2000 which claims priority to US Provisional Application Nos. 60/111,857, filed December 12, 2000 and 60/140,680, filed June 24, 1999.

### *Response to Restriction*

Applicants' election with traverse, of Group II, claims 12-42 (all claims in part),



drawn to the compounds represented by formula (XX), and specific compound No. 128-3 in Table 13 of the specification in response filed April 14, 2004 is acknowledged.

Applicant's arguments filed April 14, 2004 have been fully considered but they are not persuasive with respect to the restriction requirement. Applicants argue that the restriction requirement does not establish that searching all the inventions would constitute an undue burden to the Patent Office. Applicants argue that groups can be searched together and would not be unduly burdensome. Applicants also admit that the claimed invention groups are patentably distinct (See response to restriction requirement page 2, line 7).

However, even though an art rejection has not been made in this application, the requirement for restriction is maintained and the search has not been extended. It is pointed out that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to limit the examination of an application where **two** or **more** independent and distinct inventions are claimed to only **one** invention. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) the claimed

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subject matter accordingly. Thus, the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. No where to Applicants argue to the contrary. No where do Applicants point out and give reasons why the claims do not involve independent or distinct subject matter. Accordingly, the restriction is proper. Moreover, it would constitute a burden to extend the search because separate search considerations would be involved in both the U.S. Patents and in the literature. The examination process following the search could easily result in different and thus burdensome considerations.

The restriction requirement here is predicated on the premise that the various compounds involved differ in structure and element so much so as to be patentably distinct, i.e. a reference which anticipated the elected compounds claimed would not even render obvious the others. Again, 35 U.S.C. 121 gives the Commissioner (Director) the authority to limit the examination of an application to a single invention. Applicant has not presented evidence that the examined subject matter is patentably indistinct from the non-examined subject matter. Nor have the even argued to the contrary. Accordingly, the requirement to restrict is considered proper and is maintained. The search and examination of the application is directed to the generic embodiment identified for examination only.

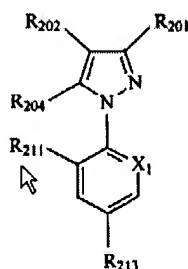
In accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims and method of use claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product claims and process is deemed proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Status of the Claims*

Claims 1-48 are pending in this application. Claims 1-11, 12-42 (all claims in part) and 43-48 as previously stated, are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

The scope of the invention of the elected subject matter is as follows:



Compounds of formula , (XX) ,depicted in claim 12, wherein:

R<sub>201</sub> is as defined; R<sub>202</sub> is S(O)<sub>h</sub>CF<sub>3</sub>; h is 1; R<sub>204</sub> is N(R<sub>205</sub>)C(O)aryl; R<sub>205</sub> is as defined; Aryl is selected from the group consisting of 2-thienyl, 3-thienyl, 2-furyl, 3-furyl, 5-chloro-2-furyl, 5-trifluromethyl-2-furyl, 5-methoxy-2-thienyl and 5-trifluromethyl-2-thienyl; R<sub>211</sub> and R<sub>213</sub> are as defined; X is C- R<sub>212</sub>; R<sub>212</sub> is a halogen.

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The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) the claimed subject matter accordingly. For example, the claims encompass aryl groups as 5- or 6-membered rings optionally having a hetero ring atom which is S, O or N. These are variously classified, therefore "aryl" has been restricted out of the generic embodiment identified for examination. The following is an illustration of the varied classification of the aryl groups: pyrazinyl is classified in class 544 and subclass 336+; pyrimidinyl is classified in class 544 and subclass 242+; pyridinyl is classified in class 546 and subclass 268.1+; oxazolyl is classified in class 548 and subclass 215+; thiazolyl is classified in class 548 and subclass 146+; etc. . . Thus, the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. No where to Applicants argue to the contrary. No where do Applicants point out and give reasons why the claims do not involve independent or distinct subject matter. Accordingly, the restriction is proper. Moreover, it would constitute a burden to extend the search because separate search considerations would be involved in both the U.S. Patents and in the literature. The examination process following the search could easily result in different and thus burdensome considerations.

As a result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claim 12-42 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions.

Claims 12-42 are objected to for containing non-elected subject matter

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed whose telephone number is (571) 272-0705. The examiner can normally be reached on M-T 7:00 AM- 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

*Kamal Saeed*  
Kamal Saeed, Ph.D.,  
Patent Examiner, Art 1626